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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,440	08/01/2001	Rajendra Singh	SURR.62	6604
25871	7590	11/16/2004		
SWANSON & BRATSCHE L.L.C.				
1745 SHEA CENTER DRIVE				
SUITE 330				
HIGHLANDS RANCH, CO 80129				
EXAMINER				
CROSS, LATOYA I				
ART UNIT		PAPER NUMBER		
1743				

DATE MAILED: 11/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/920,440

Applicant(s)

SINGH ET AL

Examiner

LaToya I. Cross

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-26 and 89-103 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-26 and 89-103 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8-16-04
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

10-4-04

DETAILED ACTION

This Office Action is in response to Applicants' amendments filed on August 16, 2004.

Withdrawal of Rejections from Previous Office Action

- The anticipation rejection over Markell et al is withdrawn in view of Applicants' incorporation of encoded extraction probes into the independent claims. Likewise, the obviousness rejection over Markell et al in view of Childs et al is also withdrawn.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
2. Claims 10-26 and 89-103 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent Publication 2003/0036096 to Ravkin et al.

Ravkin et al teach a chemical library method for detection and quantification of target analytes. The method comprises contacting the sample having target molecules with a chemical library composition. The chemical library composition is disposed on a carrier as a detectable code combination. Each carrier has a code combination defined detectable indicia at a particular position on the carrier (¶ 29). The reference teaches that as many as M^N ($M > 2$

and $N > 2$) number of different code combinations may be possible, as recited in claims 22-25 and 99-102. The detectable indicia are equivalent to Applicants' extraction probes. The carrier may be a nanoparticle, such as a nanocrystal prepared with fluorescent probes (§ 57). After the sample is contacted with the carrier having the detectable code combinations, the carriers are "scanned" for decoding and identifying the specific compound carried on the carrier. With respect to claim 11, Ravkin et al teach that the carriers may be segmented (§ 52). With respect to claims 12, 13 and 89, the reference teaches that the carriers have at least $N > 1$ specified code positions and $M > 1$ detectable indicia at each code position and a different chemical compound carried on each different coded carrier (§ 38). ~~Was~~ Thus, each indicium may be differentiated by its code position or its chemical composition. With respect to claims 14-16 and 91-93, Ravkin et al teach examining and scanning the carriers for the presence of bound analytes by light microscopy, wherein the target is detectable in its native form or by a fluorescent label (§ 47-48). Regarding claims 20-21, 97 and 98, Ravkin et al teach that the detectable indicia may be oligonucleotides, peptides, nucleic acids or receptors (§ 38).

Therefore, for the reasons set forth above, Applicants' invention is deemed to be anticipated by Ravkin et al.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

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provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 10 and 14-16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 16-19 of copending Application No. 09/688,063. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant method claims use different encoded extraction phases, whereas the claims of the '063 application recite combinatorially-derived encoded extraction phases. The claims are not patentably distinct because the instant claims (reciting "different" encoded extraction phases) are merely broader than the claims of the '063 application (reciting "combinatorially derived" encoded extraction phases). Thus, the instant claims are anticipated by the claims of the '063 application. See In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

5. Applicant's arguments with respect to claims 10-26 and 89-103 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaToya I. Cross whose telephone number is 571-272-1256.


The examiner can normally be reached on Monday-Friday 8:30 a.m. - 5:00 p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Jill Warden
Supervisory Patent Examiner
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